

REMARKS

By the present Amendment, Applicant has amended claims 1, 5-8, and 12.

Claims 1-14 remain pending in this application.

In the January 10, 2007 Final Office Action, the Examiner rejected claims 1-14 under 35 U.S.C § 101 as being directed to non-statutory subject matter; rejected claims 1, 3, 5-7, and 9-12 under 35 U.S.C § 103(a) as being unpatentable over U.S. Patent No. 6,647,383 to August et al. ("*August*") in view of U.S. Patent No. 5,317,725 to Smith et al. ("*Smith*"); rejected claims 2, 4, and 14 under 35 U.S.C § 103(a) as being unpatentable over *August* and *Smith*, in further view of U.S. Published Patent Application No. 2002/0073200 to Babutzka et al. ("*Babutzka*"); rejected claim 8 under 35 U.S.C § 103(a) as being unpatentable over *August* and *Smith*, in further view of U.S. Published Patent Application No. 2002/0133347 to Schoneburg et al. ("*Schonenburg*") and U.S. Patent No. 6,360,216 to Hennessey et al. ("*Hennessey*"); and rejected claim 13 under 35 U.S.C § 103(a) as being unpatentable over *August* and *Smith*, in further view of U.S. Published Patent Application No. 2001/0056379 to Fujinaga et al. ("*Fujinaga*").

Applicant respectively traverses the rejections presented in the Office Action and requests allowance of the pending claims.¹

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to certain assertions or requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

I. Rejection under 35 U.S.C § 101

The Examiner rejected claims 1-14 for lacking a “substantial practical application.” The Examiner further argues that, with regard to claim 1, “[s]olutions that are applied to solve a problem is vague and not a practical application.” (Final Office Action, page 3, lines 1-2). Applicant has amended claim 1 to recite “wherein the identified solutions are applied to solve the problem identified in the main system,” and assert that claim 1, as amended, serves a practical application. Accordingly, Applicant request the Examiner to withdraw the rejection under 35 U.S.C § 101.

Independent claims 7 and 12, while different in scope, recite limitations similar to that noted above with respect to amended claim 1. Accordingly, Applicant submits that claims 7 and 12 are directed to statutory subject matter and request the Examiner to withdraw the rejection under 35 U.S.C § 101.

II. Rejection of claims 1, 3, 5-7, 9-12 under 35 U.S.C § 103(a)

Applicant respectfully traverses the rejections of claims 1, 3, 5-7, and 9-12 under 35 U.S.C. § 103(a) because no *prima facie* case of obviousness has been established. As M.P.E.P. § 2142 states, “[t]he Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.”

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim

limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006), p. 2100-125, 126.

Each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143.

Here, no *prima facie* case of obviousness has been established for at least the reason that the cited references fail to teach or suggest each and every element of claims 1, 3, 5-7, and 9-12.

Independent claim 1 recites, *inter alia*, "a knowledge module configured to receive the knowledge representations and store the knowledge representations with sets of semantically grouped solution identification rules." *August* and *Smith*, taken individually or in any proper combination, do not teach or suggest at least the above element of independent claim 1.

The Examiner asserts that the claimed "solution identification rules" are taught by *August* and argues that "[d]efining solution identification rules' of applicant is equivalent to 'definitions of important features' of *August*." (Office Action, page 23, lines 21-25). However, the Examiner's assertion is incorrect. *August* is directed to information searching, such as an Internet search engine (*August*, Abstract). In addition to being able to retrieve data, the user may also retrieve associated features with that data. "Often there are features in the data items returned that are not obvious to the person using the system...they are the characteristics that are easily used to separate the highly referenced items from the rare items." (*August*, column 14, lines 12-20,

emphasis added). The Examiner appears to alleges that these data “characteristics” supplied to the user constitute “solution identification rules,” as recited in independent claim 1. However, this is not correct because the “characteristics” of *August* merely constitute information about search results that would not ordinarily be made available to the user, but do not disclose or suggest “solution identification rules,” as recited in independent claim 1 (emphasis added). Furthermore there is no solution being identified in *August*, but rather only information regarding search results. Accordingly, the characteristics of *August* are not related to a “solution,” nor are they related to any “solution identification.” Therefore, *August* does not teach or suggest storing “the knowledge representations with sets of...solution identification rules,” as required by independent claim 1.

Moreover, there is no teaching or suggestion in *August* regarding the “solution identification rules” being “semantically grouped,” as required by independent claim 1 (emphasis added). In fact, *August* is completely silent with respect to these noted limitations.

Furthermore, *Smith* fails to cure the deficiencies of *August*. That is, *Smith* fails to teach or suggest “a knowledge module configured to receive the knowledge representations and store the knowledge representations with sets of semantically grouped solution identification rules,” as recited by independent claim 1. Accordingly, *August* and *Smith*, whether taken alone or in combination, fail to teach each and every element of claim 1. For at least these reasons, the rejection of claim 1 under 35 U.S.C § 103(a) is improper and should be withdrawn.

Independent claims 7, and 12, while different in scope, contain similar recitations as discussed above with respect to claim 1. As mentioned above, *August* and *Smith* fail to teach or suggest each and every element of claim 1. Therefore, *August* and *Smith* also fail to teach or suggest each and every element of claims 7 and 12 for similar reasons. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 7 and 12 under 35 U.S.C § 103(a).

Claims 3, 5-6, and 9-11 depend from claims 1 or 7 and, therefore, require all elements thereof. As noted above, *August* and *Smith* fail to teach or suggest each and every element of claims 1 and 7. Therefore, *August* and *Smith* fail to teach or suggest each and every element of claims 3, 5-6, and 9-11 at least due to their dependencies. Therefore, the rejection of claims 3, 5-6, and 9-11 under 35 U.S.C § 103(a) should be withdrawn.

III. Rejection of claims 2, 4, and 14 under 35 U.S.C § 103(a)

Claims 2, 4, and 14 depend from independent claim 1 and, thus require all elements thereof. As noted above, *August* and *Smith* alone or in combination fail to teach or suggest each and every element of independent claim 1. Therefore, *August* and *Smith* fail to teach each and every element of claims 2, 4, and 14 at least due to their dependence.

Furthermore, *Babutzka* fails to cure the deficiencies of *August* and *Smith*. That is, *Babutzka* fails to teach or suggest “a knowledge module configured to receive the knowledge representations and store the knowledge representations with sets of

semantically grouped solution identification rules," as required by independent claims 1. Therefore *August*, *Smith*, and *Babutzka*, taken alone or in combination, fail to teach each and every element of claims 2, 4, and 14, and the rejection under 35 U.S.C § 103(a) should be withdrawn.

IV. Rejection of claim 8 under 35 U.S.C § 103(a)

Claim 8 depends from independent claim 7. As discussed above, *August* and *Smith* do not teach or suggest each and every element of independent claim 7. Moreover, *Schonenburg* and *Hennessey* do not make up for the deficiencies of *August* and *Smith*. That is, *Schonenburg* and *Hennessey* do not teach or suggest receiving the knowledge representations by a knowledge module" and "storing the knowledge representations with sets of semantically grouped solution identification rules by the knowledge module of the service system," as recited in claim 7. Accordingly, *August*, *Smith*, *Schonenburg*, and *Hennessey*, individually or in any proper combination, do not teach or suggest each and every element of claim 8, at least due to its dependence from claim 7. Therefore, the Examiner should withdraw the rejection of claim 8 under 35 U.S.C § 103(a).

V. Rejection of claim 13 under 35 U.S.C § 103(a)

Claim 13 depends from independent claim 1 and thus require all elements thereof. As noted above, *August* and *Smith* fail to teach or suggest each and every

element of independent claim 1. Therefore, *August* and *Smith* fail to teach or suggest each and every element of claim 13 at least due to its dependence from claim 1.

Furthermore, *Fujinaga* fails to cure the deficiencies of *August* and *Smith*. That is, *Fujinaga* fails to teach or suggest "knowledge representations with sets of semantically grouped solution identification rules," as required by independent claim 1. Therefore *August*, *Smith*, and *Fujinaga*, taken alone or in combination, fail to teach or suggest each and every element of claim 13, and the rejection under 35 U.S.C § 103(a) should be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicant requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 10, 2007

By: 

C. Gregory Gramenopoulos
Reg. No. 36,532